

### REMARKS

The Office Action of January 23, 2009 has been carefully reviewed and these remarks are responsive thereto. Claims 12 and 13 have been added in the present paper. No new matter has been added. Claims 1-13 are presented for examination upon entry of the present paper. Reconsideration and allowance of the instant application are respectfully requested.

#### Claim Rejections Under 35 U.S.C. § 112

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 1 stands rejected based on the recitation of “causing **substantially continuous** transmission of said first set . . .” *See* the Office Action at page 2. This rejection is traversed.

Applicant refers the Office to MPEP § 2173.02 for a discussion of the principles to be applied in determining compliance with section 112, second paragraph. As discussed therein, the focus of the inquiry should be whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available; the subject matter of the claim merely needs to be defined with a reasonable degree of particularity and distinctness. Emphasis in original. Furthermore, MPEP § 2173.05(b) specifically allows for a recited feature to include the qualifying term “substantially.”

MPEP § 2173.02 provides that definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure. Referring to the originally filed specification at page 9, line 17 – page 10, line 9, and Figure 2, a continuous source 202 is described that provides a substantially continuous stream of video-programming. In the same passage, continuous source 202 is contrasted with an on-demand source 204 that provides video-programming only upon request from subscriber stations 106 (via a respective session control manager (SCM) 212 for particular programming). Applicant respectfully submits that the contrast between the

provisioning of video-programming between continuous source 202 and on-demand source 204 would have served to reasonably apprise one of ordinary skill in the art what Applicant regarded as the invention, with a sufficient degree of clarity and precision.

In the event that the Office maintains a rejection of claim 1 based on the recitation of a “substantially continuous transmission,” Applicant respectfully requests the Office to indicate why the language has been interpreted as indefinite in order to provide Applicant with a more substantive basis for responding. Moreover, in the event that the Office maintains a rejection of claim 1 under section 112, second paragraph based on the above-noted features, Applicant invites the Office to suggest alternative claim language pursuant to MPEP § 2173.02.<sup>1</sup>

### **Claim Rejections Under 35 U.S.C. § 103**

Claims 1-3, 9, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,211,901 to Imajima et al. (“Imajima”). Claims 4, 5, 7, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Imajima in view of U.S. patent no. 5,592,470 to Rudrapatna et al. (“Rudrapatna”). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Imajima and Rudrapatna, and further in view of U.S. patent no. 5,940,738 to Rao (“Rao”). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Imajima and Rudrapatna, and further in view of U.S. patent no. 5,920,700 to Gordon et al. (“Gordon”). These rejections are traversed below.

Amended independent claim 1 recites, among other features,

*“determining, at said head-end, whether said requested video program is associated with one of a predetermined plurality of subsets of video channels, wherein said plurality of subsets of video channels comprises a first subset of video channels representing a first subset of*

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<sup>1</sup> In requesting the Office to provide a recommendation, Applicant respectfully maintains that the current claim language is definite. Applicant merely requests the Office’s assistance in order to advance the prosecution beyond mere technical rejections. See MPEP § 706.03 (discussing that the primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art, and that effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical, and further providing that where a major technical rejection is proper such a rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression).

video broadcast channels having a first subscriber viewership level greater than a threshold level, a second subset of video channels representing a second subset of video broadcast channels having a second subscriber viewership level less than said threshold level.”

(Emphasis supplied). Illustrative, non-limiting written description support for the amended features recited in claim 1 is provided in the originally filed specification when read as a whole, and, for example, at page 9, lines 3-16 and Figure 1.

Imajima fails to describe at least the above-noted features recited in claim 1. Instead, Imajima at col. 6, line 9 – col. 7, line 9 and Figure 8 describes a video data distributing device that includes a service switch determining unit 2 that determines whether newly requested video data causes videos managed by a load state management unit 1 to exceed a predetermined threshold. In Imajima, when the videos managed by load state management unit 1 exceeds the threshold, the service switching determining unit 2 switches the type of service from full-video-on-demand (FVOD) to near-video-on-demand (NVOD). Thus, Imajima teaches away from the above-noted features related to determining whether a requested video program is associated with one of a predetermined plurality of subsets of video channels. Namely, in Imajima the class of service (FVOD or NVOD) assigned to a requested video data is based on whether that request exceeds a capacity (as defined by a threshold) of load state management unit 1.

For at least the foregoing reasons, claim 1 is allowable.

Claims 2-11 depend from claim 1, and are allowable for at least the same reasons as claim 1 because none of the additional applied art (Rudrapatna, Rao and Gordon) cures the deficiencies of Imajima described above (notwithstanding whether such combinations of references would have been proper). Moreover, claims 2-11 are further allowable in view of the additional features recited therein.

For example, claim 10 recites “allocating a plurality of channel slots for each of said portions of channels.” The Office Action at pages 5-6 correctly indicates that Imajima fails to describe such features and relies on Rudrapatna to allegedly cure the deficiencies of Imajima. The Office contends that it would have been obvious to one of ordinary skill in the art to modify Imajima’s system to include allocating a plurality of channels slots for each of the portions of channels to keep track of available channels,

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thereby achieving more efficient bandwidth management. Applicant respectfully disagrees. As described above in conjunction with claim 1, Imajima describes allocating a service type (FVOD or NVOD) upon receipt of a request for video data. Allocating a plurality of channel slots would run counter to the intended purpose of Imajima of dynamically allocating video to a particular service type based on whether a capacity threshold is exceeded. As such, one of ordinary skill in the art, starting from Imajima, would not have had an apparent reason to modify Imajima to include the alleged teachings of Rudrapatna. As such, claim 10 is allowable for at least these additional reasons.

### **CONCLUSION**

If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account 19-0733 in the appropriate amount.

All rejections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

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